



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,709	07/16/2002	Zwi H Kalman	Kalman-1	4596

28581 7590 06/01/2005

DUANE MORRIS LLP
PO BOX 5203
PRINCETON, NJ 08543-5203

EXAMINER

HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
----------	--------------

1731

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049,709

Applicant(s)

KALMAN ET AL.

Examiner

John Hoffmann

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-16, 18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-16, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The previous holding of non-responsive reply (1/28/05 & 4/7/2005) is herein withdrawn.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Therefore, the interconnected networks, the distributed particles along the grain boundaries, the average spacing and the grain boundaries surrounded by particles (claim 18) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The above mentioned details are essential for a proper understanding of the invention. See the rejection under 35 USC 112 as to why the details of the invention cannot be understood – and therefore the requisite drawings are essential for a proper understanding of the invention.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

Art Unit: 1731

changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-16 and 18-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 requires that the second phase is an interconnected network, and yet it comprises particles. Particles are discrete and not interconnected. Thus claim 14 is requiring two mutually exclusive things for the second phase. Examiner could not find anything in the specification or drawings which discloses any detail about how the second phase could be an interconnected network and yet have particles. The only mention that Examiner could find was at pages 9-10; but such is only a mention – it does not serve to be any sort of description. It is also noted that the previous Examiner held that particles cannot be part of an interconnected network.

Art Unit: 1731

See Allen Eng'g Corp. V. Bartell Indus. Inc. 299 F.3d 1336, 1348, 63 USPQ2d 1769, 1775 (Fed. Cir. 2002) (quoting Personalized Media Communications, LLC v. Int'l Trade Comm'n, 161 F.3d 696, 705, 48 USPQ2d 1880, 1888 (Fed. Cir. 1998)) ("In determining whether the claim is sufficiently definite, we must analyze whether "one skilled in the art would understand the bounds of the claim when read in light of the specification.") See also, Exxon Research & Eng'g Co. v. United States, 265 F.3d 1371, 1375, 60 USPQ2d 1272, 1276 (Fed. Cir. 2001) (citation omitted) (patent claims must be "sufficiently precise to permit a potential competitor to determine whether or not he is infringing").

For the above reasons, it is deemed that a potential infringer would not be able to determine whether or not s/he is infringing. For example, a potential infringer could not determine whether a particular interconnected network phase includes particles, or whether a particular phase of particles constitute an interconnected network.

Also, claim 14 refers to grain boundaries of the first phase: the term "grain" is substantially the same as "particle". If the first phase is of grains, then they aren't interconnected. Applicant must be using some special definition for interconnected, network, particle and/or grains. One of ordinary skill cannot determine what is meant by these things.

Furthermore, claim 18 requires the grain boundaries of the first particles are surrounded by the particles. If the all/each boundaries are surrounded, then the first phase grains are all isolated/surrounded. If they are surrounded, then they cannot be interconnected. One would not understand what sort of materials would infringe and which would not infringe.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 14 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olry 5132169 alone, or in view of Barton 5413687.

Art Unit: 1731

See how Olry was previously applied. As to the new limitation of particles: Olry's fibers (col. 4, line 43) are particles. See Barton, col. 3, lines 40- 46 which indicates that ceramic fibers of 100 mm in length can be considered to be particles. As to the particles being distributed along grain boundaries: it is clear that the fibers are in contact with the matrix (i.e. the first phase). Wherever they are contacted, there is a grain boundary.

Claim 18 It is deemed that the claim is met. Because each grain boundary between the first phase and the fibers, is essentially a tube. Thus each tube grain boundary is internally surrounded by the fiber particle. There is one fiber per tube; this reads on the "up to 10"

Claim 19: "the" average spacing is interpreted to be "an" average spacing, because there are numerous average spacings. It is deemed that since the Olry fibers/particles are in the form of a woven cloth, that all the fibers are in contact with other fibers/particles and thus the average spacing is 0.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Olry and Barton as applied to claim 14 above, and further in view of Sacks 5851942.

See how Olry and Wapner where previously combined.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Olry and Barton as applied to claim 14 above, and further in view of Wapner 6706401.

See how Olry and Wapner where previously combined.

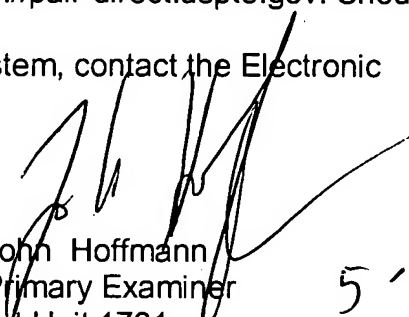
Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John Hoffmann
Primary Examiner
Art Unit 1731

5-23-05

jmh